

## REMARKS

Applicant gratefully acknowledges the courtesy of the Examiner in granting an interview to Applicant's representative Stuart Atlow, registration number 56,503, on 1 December 2009. In the interview, proposed amendments to claim 69 were discussed in view of US 2002/0144262 of Plotnick, et al, as well as US 6,798,893 to Tanaka and US 2004/0096002 of Zdepski et al. Agreement was not reached.

Applicant has carefully studied the outstanding Official Action. The present amendment is intended to be fully responsive to all points of rejection and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the present application are hereby respectfully requested.

Claims 69 - 92 stand rejected under 35 USC 103(a) as being unpatentable over Plotnick in view of Tanaka. Claims 69 - 92 also stand rejected under 35 USC 103(a) as being unpatentable over Plotnick in view of Zdepski.

Plotnick describes a system for presenting viewers with an "alternative brief advertisement" during trick play events (see Plotnick, Abstract, intra-alia). The system of Plotnick is disposed on a set top box or equivalent decoder (see Plotnick, pages 4 - 8; the discussion centers exclusively on video decoders). There are portions of Plotnick which do focus on non-decoder portions of a video system. However, those portions of Plotnick are primarily advertisement queues and queue management systems, and, as will be discussed below in greater detail, are therefore not relevant to the discussion at hand.

In the interview, the Examiner consistently took the position that anything recited in Plotnick is inherently occurring in claim 69, even though the steps recited in claim 69 are occurring prior to or during video encoding. Applicant respectfully points out that the Examiner's position, taken to its logical extreme leads to the conclusion that making a movie or other video content is the same, inherently by reflection, as watching a movie. Clearly, this is not the case, watching a movie is essentially a human endeavor which is passive by nature, and making a movie is by nature an active process.

In order to highlight this difference between the present invention, as claimed in claim 69, claim 69 has been amended to recite steps specifically drawn to the authoring of non-MPEG content, those steps including at least: the embedding the message; and the each frame of the plurality of video frames with a time line. Additionally, claim 69 has been amended to recite the video encoding of the authored content.

As was pointed out in the interview, the system of Plotnick relies on building advertisements in a set top box environment, based on processing rules and flags present in broadcast content (see, for instance, but not limited to, Plotnick paragraphs 0205 - 208, and paragraphs 0213 - 0218. In the interest of brevity, only paragraph 0207 is cited herein below):

[0207] According to one embodiment, **the frames or segments of video that make up the advertisement may be *flagged* with some type of designations.** This flagging may be performed when the advertisement is generated or anytime after ad production. The flagging of the frames may be done in numerous methods known to those of ordinary skill in the art, including but not limited to user data embedded in the compressed video stream (as defined, for example in the MPEG-2 video specification--ISO/IEC 13818-2 which is herein incorporated by reference), or as a separate packetized data stream associated and synchronized with a specific program (as defined, for example, in the MPEG-2 systems specification--ISO/IEC 13818-1 which is herein incorporated by reference), or as a separate data file that provides pointers to flagged frames in the advertisement. **If the advertisement is flagged in some fashion, the processing rules could rely on the flagging in order to generate the alternative advertisement.** Additionally, the flagging could be used to customize (target) the alternative advertisement to the subscriber that is

determined to be interacting with the program stream. As should be obvious, the generic processing rules associated with flagged advertisements are much more simple than processing rules that would be associated with the advertisement. (emphasis added)

It is clear from the portion cited above from Plotnick, that the set top box device must receive processing rules from a server (see Plotnick Fig. 13A - 13C, item 1310). Additionally, the flagging, comprising a signal to use a particular frame of a portion thereof is necessary. Flagging in Plotnick, in the absence of processing rules is worthless. Likewise, the processing rules of Plotnick, in the absence of flagging, is worthless.

The embodiment of the present invention as claimed in claim 69, however, recites that a message is embedded in a video frame during a video authoring process. At a later stage, the video is encoded to ensure that the frame comprising the embedded message is encoded as a key frame. Thus, upon trick mode playback, without any flags or processing rules, the embedded message becomes visible.

It was also discussed in the interview that one consequence of the above discussion is that in order to implement the system of Plotnick, existing set top box devices must be modified in order to support receiving and implementing the processing rules. The embodiment of the present invention as claimed in claim 69, however, is implementable, as it is today, in any set top box which supports trick mode playback.

Furthermore, as was pointed out in the interview, advertisements inserted in the system of Plotnick are dynamic (see, for instance, Plotnick paragraph 0146). Thus, an advertisement which a viewer sees today when viewing video in the system of Plotnick, need not be the same advertisement the viewer will see when viewing the exact same portion of video at a future point in time.

By contrast, the embodiment of the present invention claimed in claim 69 embeds a message into a frame which is destined to become a key frame. As a consequence of the embedding, the message remains the same advertisement

whether the portion of video comprising the embedded message is viewed now or in several years time.

An additional consequence of the above discussion of the difference between Plotnick and claim 69 is that, because Plotnick relies on processing rules and flagging, the set top box must detect the onset of trick play in order to operate. In the embodiment of the present invention claimed in claim 69, by contrast, the set top box is entirely passive in playing out the embedded message.

Applicant respectfully puts forth that the differences which are discussed above are emphasized by the present amendment of claim 69.

Applicant respectfully calls the Examiner's attention to MPEP, section 2143.03, "All Claim Limitations Must Be Considered", which states, "'All words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

See also MPEP 706.02(j) "Contents of a 35 U.S.C. 103 Rejection":

"'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

Furthermore, the Examiner is also respectfully reminded of MPEP 2141.02 "Differences Between Prior Art and Claimed Invention"

"VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

*A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.* W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)" (emphasis added).

Applicant puts forth, that, in light of the above discussion of the differences between Plotnick and claim 69, when considering the entirety of the

Plotnick reference, Plotnick fails to meet the criterion of the cited portions of the MPEP.

In that Plotnick, when considered in its entirety is not comparable to the embodiment of the present invention claimed in claim 69, applicant submits that the rejections of claims 69 - 92 under 35 USC 103(a) as being unpatentable over Plotnick in view of Tanaka and also over Plotnick in view of Zdepski are moot.

The amendment of claim 69 is supported, intra-alia, on pages 18 and 20 of the application as filed.

Claim 69 has been further amended, as a matter of clarity, to recite "hidden" or "hider" instead of "obscured" or "obscurer".

The amendment is supported, inter-alia on page 3 of the application as filed.

Claim 69 is therefore deemed allowable.

Claim 70 has been cancelled.

Claim 71 has been amended to be consistent with the recitation of amended claim 69.

The amendment of claim 71 is supported, intra-alia, on page 13 of the application as filed.

Furthermore, claim 71 depends from claim 69 and recites additional patentable subject matter.

Claim 71 is therefore deemed allowable, with reference to the above discussion of the allowability of claim 69.

Claim 72 has been cancelled.

Claim 73 has been amended to be consistent with the recitation of amended claim 69.

Claim 73 depends from claim 69 and recites additional patentable subject matter.

Claim 73 is therefore deemed allowable, with reference to the above discussion of the allowability of claim 69.

Claims 74 - 76 all depend, directly or indirectly, from claim 69, and recite additional patentable subject matter.

Claims 74 - 76 are therefore deemed allowable, with reference to the above discussion of the allowability of claim 69.

Claim 77 has been amended to increase the clarity of the claim and to make the recitation of claim 77 consistent with the recitation of amended claim 69.

Claim 77 depends from claim 69 and recites additional patentable subject matter.

Claim 77 is therefore deemed allowable, with reference to the above discussion of the allowability of claim 69.

Claims 78 - 80 all depend, directly or indirectly, from claim 69, and recite additional patentable subject matter.

Claims 78 - 80 are therefore deemed allowable, with reference to the above discussion of the allowability of claim 69.

Claim 81 has been cancelled.

New claim 97 has been added in lieu of claim 81. New claim 97 explicitly recites that the video decompressed comprises the video authored as per the method of claim 69. The motivation for the present amendment which effectively replaces claim 81 with new claim 97 is in order to stress the various differences enumerated above with respect to the amended claim 69 and Plotnick. Specifically, the video authored in claim 67 is played back as it is received by the set top box in both regular and trick play.

The amendment of claim 97 is supported, intra-alia, by Fig. 6 and the description thereof.

Claim 97 is therefore deemed allowable in view of the above discussion of the allowability of claim 67.

Claims 82 - 85, which formerly depended, directly or indirectly, from claim 81 have been amended to depend, directly or indirectly, from new claim 97, and hence from amended claim 69.

Claims 86 - 88 have been cancelled.

Claims 89 - 90 are, respectively, a system claim and an apparatus claims in means-plus-function format corresponding to method claim 69.

Claims 89 - 90 have been amended in a fashion corresponding to the amendment of claim 69.

Claims 89 - 90 are therefore deemed allowable in light of the above discussion of the allowability of claim 69.

Claims 91 and 92 have been cancelled.

Claim 93 depends indirectly from amended claim 69 and recites additional patentable subject matter.

Claim 93 is therefore deemed allowable in light of the above discussion of the allowability of claim 69.

Claims 94 - 95 depend from amended claim 69 and recites additional patentable subject matter.

Claims 94 - 95 have, for the sake of clarity been amended, similar to amended claim 69, to recite "hider" instead of "obscurer".

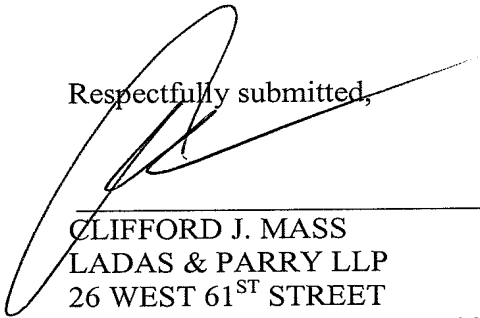
Claims 94 - 95 are therefore deemed allowable in light of the above discussion of the allowability of claim 69.

New claim 96 is supported on page 20 of the specification as filed.

In view of the foregoing remarks, it is respectfully submitted that the present application is now in condition for allowance. Favorable reconsideration and allowance of the present application are respectfully requested.

Please charge Account No.12-0425 for any fees which may be due by this paper.

Respectfully submitted,



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